



Docket No.: 16159/021001; P6416

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Syed M. Ali et al.

Conf. No.: 5348

Application No.: 09/997,927

Art Unit: 2143

Filed: November 30, 2001

Examiner: D. M. Doan

For: TRANSPARENT INJECTION OF
INTELLIGENT PROXIES INTO EXISTING
DISTRIBUTED APPLICATIONS

Assistant Commissioner for Patent
Mail Stop Appeal Brief-Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41

Dear Sir:

Pursuant to 37 C.F.R. § 41.41, please consider the following Appellant's Reply Brief in the referenced Application currently before the Board of Patent Appeals and Interferences. The present Reply Brief is in response to the Examiner's Answer dated April, 7, 2006.

TABLE OF CONTENTS

| | | |
|-------|--|---|
| I. | Real Party in Interest | 4 |
| II. | Related Appeals and Interferences..... | 4 |
| III. | Status of Claims | 4 |
| IV. | Status of Amendments | 4 |
| V. | Summary of Claimed Subject Matter | 4 |
| VI. | Grounds of Rejection to be Reviewed on Appeal..... | 4 |
| VII. | Argument | 4 |
| A. | Claims 1 and 31 | 5 |
| B. | Claim 10..... | 7 |
| C. | Claim 15..... | 7 |
| VIII. | Conclusion | 9 |

TABLE OF AUTHORITIES

CASES

| | |
|---|---|
| <i>Ex parte Levy</i> , 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) | 5 |
|---|---|

OTHER SOURCES

| | |
|---|---|
| Manual of Patent Examining Procedure 2112 (8th Edition, Revised October 2005) | 5 |
|---|---|

I. Real Party in Interest

The statement regarding the Real Party in Interest in the Appellant's Brief filed January 17, 2006 ("the Brief of Appellant") remains valid.

II. Related Appeals and Interferences

To the best knowledge of the Appellant and the Appellant's legal representative, there are no further appeals or interferences in addition to that reported in the Brief of Appellant that will directly affect, be affected by, or have a bearing on the decision of the Board in the pending appeal. Furthermore, to the best of knowledge of the Appellant and the Appellant's legal representative, there has been no decision in the earlier-reported appeal.

III. Status of Claims

The statement regarding the Status of Claims in the Brief of Appellant remains valid.

IV. Status of Amendments

The statement regarding the Status of Amendments in the Brief of Appellant remains valid.

V. Summary of Claimed Subject Matter

The Summary of Claimed Subject Matter in the Brief of Appellant remains unchanged.

VI. Grounds of Rejection to be Reviewed on Appeal

The Grounds of Rejection to be Reviewed on Appeal in the Brief of Appellant remains unchanged.

VII. Argument

The Appellant respectfully maintains the positions outlined in the Brief of Appellant. Nonetheless, the Appellant respectfully replies to the Examiner's Answer of April 7, 2006 as follows.

The following sections correspond to groupings used by the Examiner in responding to the arguments presented in the Brief of Appellant.

A. Claims 1 and 31

At the outset, the Appellant respectfully notes that claim 1 is not pending in the referenced application. However, to the extent that the Examiner's response on page 8 of the Examiner's Answer is applicable to independent claims 8 and 31, the Appellant responds as follows.

The Examiner has continued to assert that the claims do not recite "find [sic] all of the remote object [sic]." (Examiner's Answer, p. 8). The Appellant has already acknowledged in both the Request for Pre-Appeal filed November 14, 2005 (p. 2) and the Brief of Appellant (p. 8-9) that the term "all" is not present in the pending claims. However, the Appellant is still awaiting a response from the Examiner as to why the current wording of the claim, namely the phrase "analyzing the server portion to determine each of the plurality the remote objects in the server portion," is not equivalent to finding all remote objects in the server portion.

In addition to asserting that "finding each" is not equivalent to "finding all," the Examiner has asserted that the limitation "analyzing the server portion to determine each of the plurality the remote objects in the server portion" is "inherent when creating proxies for the subject object's super classes" (Examiner's Answer, p. 8). Section 2112 of the Manual of Patent Examination Procedure (MPEP) provides that:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)

The Examiner has not met the burden setout in MPEP § 2112. Rather, the Examiner has merely asserted that "the determining step is inherent when creating proxies for the subject object's super classes" (Examiner's Answer, p.

8). Clearly, such an assertion without any additional support for why the Examiner believes that the claim limitation (*i.e.*, “analyzing the server portion to determine each of the plurality the remote objects in the server portion”) *necessarily* flows from the above teach of Glass falls short of the requirements setout in the MPEP § 2112. In view of the Examiner’s failure to satisfy the requirements setout in MPEP § 2112, the Appellant respectfully requests that the Examiner withdraw this theory of rejection or provide reasoning as to why the Examiner believes that the aforementioned claim limitation *necessarily* flows from the teachings of Glass.

Finally, the Examiner has continued to assert that the “proxy acts as a middleman between the requested object and the requesting server” (Examiner’s Answer, p. 8). In continuing to assert this position, the Examiner has clearly misinterpreted the Appellant’s position with respect to this claim limitation (*i.e.*, “modifying the client portion to substitute a call for a remote object with a call for a corresponding proxy”). The Appellant acknowledges that the proxy is interposed between the client portion and the server portion, such that at least some information passes between the client portion and the server portion via the proxy.

However, the Appellant disagrees about how the client portion (as recited in the claims) interacts with the proxy and how the client in Glass interacts with the proxy. A close reading of Glass reveals that there is no *explicit* teaching of modifying the client (and more specifically the source code within the client) to replace calls to the remote object with calls to the proxy. Further, the only teaching in Glass of client-proxy communication is detailed in Figure 2. As previously stated, *each time* an object on the server is requested by the client, the steps in Figure 2 are performed. Of importance is step 30, which performs the following query “Does a proxy class exist for [sic] object on [sic] client system?” If the client was in fact modified such that calls to the object were replaced with calls to the proxy, then step 30 would not be required (*see* Brief of the Appellant, pp. 10-11). The Examiner has not provided any response to rationalize why step 30 would be required if the client had in fact been modified.

In view of the fact that the claim limitation (*i.e.*, “modifying the client portion to substitute a call for a remote object with a call for a corresponding proxy”) is not expressly taught, the Appellant requests the Examiner withdraw this rejection.

B. Claim 10

In responding to the Appellant’s assertion that the limitations of claim 10 (*i.e.*, “wherein analyzing the server portion comprises parsing machine code for the server portion”) are not taught by Glass (*see* Brief of Appellant, pp. 12-13), the Examiner has merely indicated that byte code and machine code are equivalent (*see* Examiner’s Answer, pp. 8-9). However, the Examiner has not made any attempt to indicate how the cited portions of Glass (*i.e.*, col. 9, ll. 45-55) teach all the limitations of claim 10.

To reiterate, claim 10 requires that the step of “analyzing the server portion to determine each of the plurality the remote objects in the server portion” includes parsing the machine code of the server portion. Said another way, the remote objects in the server portion are located by parsing the machine code of the server portion. The Appellant continues to assert that the cited portion of Glass (*i.e.*, col. 9, ll. 45-55) only discloses the creation of a proxy without any teaching of parsing the source code to locate each of the remote objects in the server portion. Moreover, there is no other portion of Glass which, either expressly or impliedly, discloses parsing the machine code of the server to locate each of the remote objects in the server portion. In view of the above, withdrawal of this rejection is respectfully requested.

C. Claim 15

In responding to the Appellant’s assertion that the limitations of claim 15 (*i.e.*, “modifying the client portion to substitute a call to a first lookup service that locates the remote object with a call to a second lookup service that locates the corresponding proxy”) are not taught by Glass (*see* Brief of

Appellant, pp. 13-14), the Examiner has merely indicated that Glass discloses two Object Request Brokers (ORBs) (*see* Examiner's Answer, p. 9).

Turning to the language of claim 15, claim 15 requires: (i) a first lookup service configured to lookup remote objects, (ii) a second lookup service configured to lookup proxy objects; (iii) original calls in a client portion to the first lookup service; and (iv) replacement of the original calls in the client portion with new calls to the second lookup service.

From the above requirements of claim 15, it is clear that original calls are directed from the client portion to the first lookup service and the new calls are directed from the client portion to the second lookup service. In asserting that each ORB corresponds to one of the lookup services, the Examiner has overlooked the requirement that calls originally directed to the first ORB have been modified to now be directed to the second ORB. Rather, the client-side ORB in Glass is only directed to communicate with the client and the server-side ORB is only directed to communicate with the server (*see* Glass, col. 15, l. 29- col. 18, l. 60). Because the client cannot directly communicate with the server-side ORB, it logically flows that calls in the client to the client-side ORB are not replaced with calls to the server-side ORB.

Moreover, the two ORBs disclosed in Glass are "responsible for encoding messages into an on-the-wire format and decoding the message [sic] upon receipt" (Glass, col. 12, ll. 7-9; *see also* col. 12, ll. 51-53, col. 14, ll. 10-13). From the above disclosure, it is clear that the ORBs in Glass (i) are used to facilitate communication between the client and the server and (ii) that the ORBs communicate with each other. However, Glass is completely silent with respect one of the ORBs configured to search for a proxy object and a second ORB configured to search for a remote object. In view of the above, withdrawal of this rejection is respectfully requested.

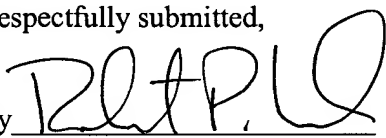
VIII. Conclusion

For the reasons presented above, claims 2-8, 10-24, and 31-32 of the '927 Application are patentable over the cited art, as Glass does not disclose all of the limitations recited therein. Therefore, the Appellant respectfully requests that the Board reverse the Examiner's rejections and allow all pending claims 2-8, 10-24, and 31-32 of the '927 Application.

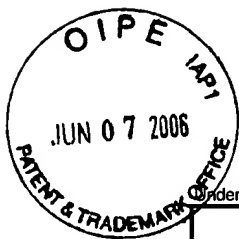
Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference No. 16159/021001).

Date: June 7, 2006

Respectfully submitted,

By 

Robert P. Lord
Registration No.: 46,479
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)



06-08-06

AF 12/01

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

| | | |
|---|------------------------|------------------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 09/997,927-Conf. #5348 |
| | Filing Date | November 30, 2001 |
| | First Named Inventor | Syed M. Ali |
| | Art Unit | 2143 |
| | Examiner Name | D. M. Doan |
| Total Number of Pages in This Submission | Attorney Docket Number | 16159/021001; P6416 |

ENCLOSURES (Check all that apply)

| | | |
|---|--|---|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard |
| Remarks | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|------------------|----------|--------|
| Firm Name | OSHA · LIANG LLP | | |
| Signature | | | |
| Printed name | Robert P. Lord | | |
| Date | June 7, 2006 | Reg. No. | 46,479 |

Attorney Docket No.: 16159/021001; P6416

Certificate of Express Mailing Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. EV809547776US in an envelope addressed to:

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on June 7, 2006
Date

Brenda C. McFadden
Signature

Brenda C. McFadden

Typed or printed name of person signing Certificate

Registration Number, if applicable

(713) 228-8600
Telephone Number

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Transmittal (1 page)
Appellant's Reply Brief Under 37 C.F.R. §41.41 (9 pages)